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JOSEPH S. TRIPOLI
THOMSON MULTIMEDIA LICENSING INC.
2 INDEPENDENCE WAY
P.O. BOX 5312
PRINCETON, NJ 08543-5312

EXAMINER

SHANG, ANNAN Q

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN SIDNEY STEWART

Appeal 2009-006552
Application 10/055,758
Technology Center 2400

Before KENNETH W. HAIRSTON, JOHN C. MARTIN,
and MARC S. HOFF, *Administrative Patent Judges*.

HAIRSTON, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1, 2, 5, 6, 8 to 12, 15, 16, and 18. Claims 3, 4, 7, 13, 14, and 17 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

Appellant's invention is concerned with a method and system for providing multimedia presentations on demand in a near on demand environment (Spec. 1:30-4:3; Fig. 1; Abs.). Appellant discloses and claims a multimedia presentation method and system that (i) authorizes a subscriber request for performance of a selected multimedia presentation, and (ii) prevents playback of authorized recordings of selected multimedia presentations based on the detection of the "completion" of the selected presentation (claims 1 and 11; Spec. 14:10-15; Fig. 4; Abs.).

Claim 1, reproduced below with emphasis in *italics*, is representative of the subject matter on appeal:

1. A method for providing multimedia presentations on demand in a near on demand environment, comprising:

a) providing beginning segments for pre-recording by subscribers where each beginning segment corresponds to ones of a plurality of multimedia presentations, each beginning segment having a duration at least as long as a predetermined time interval;

b) transmitting each one of said plurality of multimedia presentations concurrently on a plurality of channels with identical presentations transmitted on a different channel of said plurality of channels, and with a start time of each transmission having a periodic interval not exceeding said predetermined time interval,

c) responding to a subscriber request for performance of a selected one of said plurality of multimedia presentations by providing said subscriber an authorization to commence playback of one of said beginning segments corresponding to said selected one of said plurality of multimedia presentations,

said authorization comprises at least one of an authorization to commence recording said selected one of said plurality of multimedia presentations for which broadcast has already begun, and to commence playback of said corresponding one of said beginning segments, and

preventing playback of said recording of said selected one of said plurality of multimedia presentations upon completion of said presentation.

(Claim 1 (emphasis added)).

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Yoshizawa	US 6,002,694	Dec. 14, 1999
Arsenault	US 6,701,528 B1	Mar. 2, 2004
		(filed Jan. 26, 2000)

The following obviousness rejections are before us for review:

Claims 1, 2, 5, 6, 8 to 12, 15, 16, and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Arsenault and Yoshizawa.

In the rejection, the Examiner relies upon Arsenault as describing all of the features recited in independent claims 1 and 11 of a method and system for providing multimedia presentations on demand in a near on demand environment, except for preventing playback of a recording of a selected presentation when that presentation is completed (Ans. 3-4). The Examiner relies upon Yoshizawa as describing the feature common to each of independent claims 1 and 11 of preventing playback of the recording of a

selected presentation upon completion of the presentation (Ans. 4, citing column 5, lines 46 to 53 of Yoshizawa)). The Examiner interprets “completion of said presentation” (claim 1) and “presentation completion” (claim 11) as meaning the “‘end’ of viewing/re-viewing within a specific time” (Ans. 4). Therefore, the Examiner reasons, the viewer is not able to view or re-review the presentation outside of the specific time period unless the viewer has paid for the request again (Ans. 4). The Examiner concludes for the first time in the Response to Argument section of the Answer, that “it would have been obvious to one of ordinary skill in the art to modify the Arsenault system, to set up other time periods (duration of completion, e.g., an hour, two hours, etc.,) and prevent playback outside [these] time periods” (Ans. 7).

Appellant discloses the following regarding the prevention of playback of a presentation upon completion of playback:

Playback of the multimedia presentation can then terminate upon reaching the end of the record 320 at time Tstop, and shown in step 510. After the playback of the presentation is complete, the record of the selected programming or multimedia presentation can be inhibited, removed or erased from the multimedia recorder 210, *thereby preventing the user from re-performing that particular recording of the presentation.*

(Spec. 14:10-15 (emphasis added)).

Thus, Appellant describes preventing re-performance (i.e., re-viewing) of the presentation after a playback of the presentation has been completed.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). The Examiner's articulated reasoning in the rejection must possess a rational underpinning to support the legal conclusion of obviousness. *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

On the record before us, we find no supportive evidence for the Examiner's assertion (Ans. 4 and 6-7) that Yoshizawa discloses or suggests preventing playback of a presentation *upon completion of the presentation*. Specifically, we find that column 5, lines 46 to 53 of Yoshizawa discloses providing for "re-viewing" of the presentation upon completion of the presentation within a specified time period, and not prevention of playback as set forth in claims 1 and 11. Yoshizawa only *prevents* playback of a presentation in response to the detection of the expiration of a specific time period, and after that time period expires a user must pay to view (*see* col. 5, ll. 46-53). In other words, Yoshizawa prevents playback upon completion of a time period, not upon completion of the presentation itself. Thus, when presentation is completed, Yoshizawa allows for re-viewing instead of preventing a re-viewing (as long as the time period has not expired). *Id.*

Appellant argues *inter alia* (App. Br. 5-8; Reply Br. 3-4) that (i) completion of a presentation as set forth in claims 1 and 11 means the end of a viewing of a presentation, and does not mean the reviewing of a

presentation; and (ii) Yoshizawa prevents a program from being re-viewed upon the expiration of a period of time and not in response to a completion of viewing; and (iii) Arsenault and Yoshizawa, alone or in combination, do not disclose or suggest preventing playback of a selected presentation after such a presentation is completed. In light of our findings with respect to Yoshizawa, we find all of Appellant's arguments to be persuasive.

Turning to the Examiner's rationale for making the suggested modification to the on demand method and system teachings of Arsenault, we find that the Examiner's rationale (Ans. 6-7) is nothing more than unsubstantiated conclusions. In the absence of evidence to support the conclusions reached by the Examiner, and in view of our findings with respect to Yoshizawa, we will not sustain the obviousness rejection of claims 1, 2, 5, 6, 8 to 12, 15, 16, and 18. In summary, (i) the Examiner has not established a factual basis to support the legal conclusion of obviousness (*see Fine*, 837 F.2d at 1073), and (ii) the Examiner's articulated reasoning in the rejection does not possess a rational underpinning to support the legal conclusion of obviousness. *KSR*, 550 U.S. at 418.

The decision of the Examiner to reject claims 1, 2, 5, 6, 8 to 12, 15, 16, and 18 is reversed.

REVERSED

KIS

JOSEPH S. TRIPOLI
THOMSON MULTIMEDIA LICENSING INC.
2 INDEPENDENCE WAY
P.O. BOX 5312
PRINCETON, NJ 08543-5312